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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,759	09/30/2004	Nao Murakami	042704	8150

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EXAMINER	
HON, SOW FUN	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/509,759	MURAKAMI ET AL.	
	Examiner	Art Unit	
	Sow-Fun Hon	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 30 September 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/05,12/04,9/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 1-4, 7-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 10-16 of copending Application No. 10/501,959. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. While the conflicting claims have been allowed, a patent number has not been assigned as this Office Action is being written.

2. Claims 1-4 7-13 are directed to the same invention as that of claims 1-4, 10-16 of commonly assigned Application No. 10/501,959. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since

the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 5, 14-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 10-16 of copending Application No. 10/501,959. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Regarding examined claims 14-17, they are generic to and thus fully encompass the conflicting claims. Regarding examined claim 5, the limitation of "is a protective film" in the recitation of "wherein the transparent polymer film (b) is a protective film for a polarizer"

in examined claim 5, is inherent in the transparent polymer film (b) by virtue of its lamination to the polarizer in the limitation of "a laminated polarizing plate comprising an optical film and a polarizer" as recited by conflicting claim 10.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 6 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 10-16 of copending Application No. 10/501,959, as applied to claims 1-4,7-13 above, and further in view of Aomori (US 5,625,474). '959 fails to claim that the transparent polymer film (b) is a polarizer comprising a polyvinyl alcohol-based film.

However, Aomori teaches that a polarizer is a multilayer film formed by sandwiching a polyvinyl alcohol-based film between protective films of TAC (-dye type, column 8, lines 35-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have claimed that the transparent polymer film (b) is a polarizer comprising a polyvinyl alcohol-based film, in order to provide coverage for the types of polarizers commonly used, as taught by Aomori.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how transparent film (b) can be a polarizer when it has such a low birefringence, $\Delta n(b)$ less than 10 X $\Delta n(a)$, i.e. 0.00005 is less than or equal to $\Delta n(b)$ according to formulae I and III.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7-9, 11-12, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ezzell (US 5,750,641).

Regarding claims 1-2, Ezzell teaches an optical film comprising a birefringent layer (a) (birefringent polyimide, column 2, lines 24-25) and a transparent film (b) (optically transparent substrate, column 2, lines 34-39), wherein the birefringent layer is laminated directly on the transparent film (on at least one surface, column 2, lines 34-39). Ezzell teaches that the polymer forming the birefringent layer (a) has a weight-average molecular weight in the range of about 20,000 to about 140,000 (column 5, lines 61-63), which is within the claimed range of 10,000 and 400,000 inclusive.

Regarding formulae I, 3, Ezzell teaches that the birefringent layer (a) has an absolute birefringence value $|\Delta n(a)|$ of from about 0.001 to about 0.2 (column 2, lines 30-34), which is within the claimed range of 0.0005 and 0.5, and is at least 10 times greater than the birefringence value of the optically transparent film which is near zero, being isotropic (column 2, lines 34-39), $\Delta n(b) \sim 0$, thus satisfying the condition of $\Delta n(a) > \Delta n(b) \times 10$.

Regarding formula 2, Ezzell teaches that for the birefringent layer, nx, ny, and nz represent refractive indices in an X-axis direction, a Y-axis direction, and a Z-axis direction in the birefringent layer (a), respectively, with the X-axis direction being an axial direction exhibiting a maximum refractive index within a plane of the birefringent layer (a), the Y-axis direction being in an axial direction perpendicular to the X-axis within the plane, and the X-axis direction being a thickness direction perpendicular to the X-axis and the Y-axis (x and y are in the plane of the polyimide film, and z is perpendicular to it, column 12, lines 37-43), $nx = ny > nz$ (column 12, lines 42-43), which satisfies the condition of $(nx - ny) < (nx - nz)$, equivalent to the claimed condition of $1 < (nx - nz) / (nx - ny)$.

Regarding claims 3-4, Ezzell teaches that the polymer forming the birefringent layer (a) is a polyimide (column 2, lines 49-54), which is a non-liquid crystalline polymer.

Regarding claims 5, 7, 16, Ezzell teaches that the polyimide birefringent layer (a) can be coated on the inner surface of a polarizer (column 8, lines 37-44), resulting in a laminated polarizing plate, which is an optical element, and thus the optical film

functions as a protective film for the polarizer by virtue of its location as the outermost layers on the surface of the polarizer (column 2, lines 43-46).

Regarding claims 8-9, 11-12, 14-15, Ezzell teaches a liquid crystal display comprising a liquid crystal cell and an optical member, the optical member being arranged on at least one surface of the liquid crystal cell, wherein the optical member is the optical film comprising the polyimide birefringent layer (a) coated on the transparent polymer film (b) (coated on one or both sides of a liquid crystal cell, column 8, lines 36-43). Fig. 2 of Ezzell shows the liquid crystal display panel 30 containing liquid crystal cell 32 and the optical member is the laminated polarizer plate comprising the polarizer 36 and the optical film 38 comprising a multilayer construction (column 11, lines 18-37).

Regarding claim 17, Fig. 2 of Ezzell shows an optical element comprising the multilayer optical film construction 38 and a birefringent film (retarder layer 34, column 11, lines 25-37).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzell as applied to claims 1-5, 7-9, 11-12, 14-17 above, and further in view of Aomori (US 5,625,474).

Ezzell has been discussed above, and fails to teach that the polarizer comprises a polyvinyl alcohol-based film.

However, Aomori teaches that a polarizer is a multilayer film formed by sandwiching a polyvinyl alcohol-based film between protective films of TAC (-dye type, column 8, lines 35-38) for the purpose of utilizing the properties of the polyvinyl alcohol-based film.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have used a polarizer comprising a polyvinyl alcohol-based film for the polarizer of Ezzell, in order to utilize the properties of the polyvinyl alcohol-based film, as taught by Aomori.

9. Claims 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezzell as applied to claims 1-5, 7-9, 11-12, 14-17 above, and further in view of Dehmlow (US 6,359,669).

Ezzell has been discussed above, and teaches a liquid crystal display, but fails to teach a self-light-emitting display.

However, Dehmlow teaches that a self-light-emitting display can be used in place of a liquid crystal display (column 4, lines 34-45) for the purpose of providing the desired display characteristics.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have used a self-light-emitting display in place of the liquid crystal display of Ezzell, in order to provide the desired display characteristics, as taught by Dehmlow.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number (571)272-1492. The examiner can normally be reached Monday to Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571)272-1498. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Hon

Sow-Fun Hon

01/09/06

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/9/06